



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,232	05/31/2000	Daniel J. Greden	MCS-119-99	2434
27662	7590	10/18/2005	EXAMINER	
LYON & HARR, LLP 300 ESPLANADE DRIVE, SUITE 800 OXNARD, CA 93036			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/584,232
Filing Date: May 31, 2000
Appellant(s): GREDEN ET AL.

MAILED

OCT 31 2005

GROUP 3600

Ms. Katrina Lyon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7-28-05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,014,638	01-2000	Burge
6,470,338 B1	10-2002	Rizzo

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims: This rejection is set forth in Final Office Action.

(10) *Response to Arguments*

Appellant remarks at page 3 - 9 of the brief that the references are (1) missing claim elements such as manually and select and (2) at page 6 that Burge does not

provide the identity of suitable buyer to suitable agent as well as at pages 8 – 9 that Rizzo does not automatically provide the identify of the buyer to a seller.

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moreover and in response to applicant's arguments at page 5 and page 9 that the references fail to show certain features of applicant's invention, it is noted that the features upon which Appellant relies (i.e., "manually" and "select") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Appellant argues further at pages 7 and 8 that Burge never reveals nor states that the identity of the buyer is provided to the seller. However and as noted in the Final Rejection at page 9, Burge does disclose online purchasing whereby the identity of the purchaser is disclosed the seller (Col 1,lines 48 – 50 and Col, 33 -35). Additionally, Burge was not the reference used to address the claim limitations of "automatically providing the identity of the suitable buyer to the suitable agent without action from the agent". Moreover, it is well known that in online purchasing, the identity of the online shopper/buyer is revealed to the seller/merchant, which was not disputed

by the Appellant (see Final Rejection page 9). Thereby, Burge would teach one of ordinary skill in the art that the buyer reveals their identity to the seller (Col 7, lines 26 – 33). Thus, Burge discloses and teaches a computer implemented method and system for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions: providing the buyer with an interactive environment having information relating to the products or services offered by the agents (see at least Abstract and Figures 2A & B), creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment (see at least Col 3, lines 1 – 17), comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer (see at least Col 5, lines 16 – 37 and lines 51 -67 as well as Col 6, lines 1 – 5).

Second, it is worth noting and as stated in the Final Rejection at page 4 that the Appellant did not define "identity" and thereby was provided an interpretation of the word "identity" used during examination. While the Appellant argues at page 8 and 9 that this is insufficient identity information for the agent/seller to directly contact a buyer, it is important to note that the teachings of Rizzo, which the definition applies are in line with the Appellants specification as well as the claim wording. For example, Figures 5 and 6 of the Appellant's specification disclose and teach one of ordinary skill that the seller is automatically sent an email – with no identifying information other than a link stating "3 New Leads". In turn, the seller/agent as taught by the Appellant's disclosure

must "manually" move the cursor via the attached mouse and then "manually" click on the link in order to obtain the identity of the buyer. Rizzo discloses the same method of the seller being sent automatically an email with the identity (see Final Rejection definition page 4) of the buyer after it is matched to a suitable seller (see at least Abstract and Figure 5). In turn, the seller clicks on the link to obtain additional information on the needs of the identified buyer (see at least Abstract, Col 1, lines 54 – 57, Col 4, lines 12 - 21 and Figure 5). Therefore, Rizzo would teach one of ordinary skill a method for automatically providing the identity of the suitable buyer to the suitable agent without action from the agent (see at least Abstract, Col 1, lines 54 - 57, Col 4, lines 12 - 21 and Figures 4 and 5).

Appellant argues at page 10 and 11 of the brief that there is no motivation to modify Burge with Rizzo. In addition, the Appellant argues that combination of Burge and Rizzo would destroy the stated automated function of Burge.

First and in response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case

and as disclosed in the Final Rejection at page 10 and 11, the problem to be solved is to more effectively and efficiently match buyers and sellers in an online environment and thereby enhance the matching process with the corresponding benefits for both (see Burge at least Col 3, lines 12-17 and lines 57 - 59 and Rizzo see at least Abstract). In this case, the references disclose and teach one of ordinary skill that there is a need to match buyers and sellers more efficiently and efficiently. For example, Burge discloses a method and system and a need for more effectively matching buyers and sellers based on and meeting the criteria/attributes requirements of each as well as the corresponding benefits for both (see at least Col 3, lines 1 – 17 and Col 5, lines 26 – 37 and Col 6, lines 2 - 14). In turn, Rizzo discloses an online method and system that identifies a need for more effectively matching buyers and sellers, which are based on and more closely match the criteria/attributes requirements of each party (see at least Abstract, Col 1, lines 24 – 48 and Figure 5). In this manner, both parties save time in the search for the other and save the seller money as well. Thereby, the two references disclose the need for more effective matching process and thereby the obvious combination of the two further enhances the matching process - without destroying either the intent or the technology of the other reference. Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Burge with a method and system for automatically providing the identity of the suitable buyer to the suitable agent without action from the agent. In this manner, the effectiveness and efficiency of the matching process for both are enhanced and thereby lessen the burden

on each for locating and transacting with the other parties that most closely satisfy each entities criteria/attributes requirements.

Second and in response to Appellant's argument at page 10 and 11 that modifying Burge with Rizzo would destroy Burge's automated function - by the substitution of the manual actions required by Rizzo, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case and as noted above, the references are focused on solving the same problem and do disclose all the claim language recited in Claim 1. While the Appellant argues that Burge does not allow the seller to "select" the buyer he wishes to do business with, the claim language does not include any limitations such as "select". Rather, the claim language only recites "creating a profile of the buyer by inferring criteria desired by the buyer....comparing the profile and the inferred criteria wit the criteria of the products and services offered by the agents" – which Burge as noted above discloses. Furthermore and while the Appellant argues that by modifying Burge with Rizzo would destroy Burge's automated function by the substitution of the manual actions required by Rizzo, Burge as well as Rizzo disclose to one of ordinary skill that "manual" efforts are required by the buyer/shopper to obtain required information and to purchase and more importantly to enable the capture of information for establishing a preference profile for the buyer/shopper. For

example in Burge, the buyer/shopper must “manually” move the cursor and “manually” click on a product and/ or “manually” input text to purchase, which are part of the buyers interaction with interactive environment (see at least Col 7, lines 26 – 33). In turn, the “manual” efforts of Rizzo as discussed above captures input and automatically provides the identity of the suitable buyer to the suitable agent - without any action from the seller/agent (see at least Abstract and Figure 5). Thereby, the combination, which focuses on solving the same problem, are not in contradiction nor destroy the intent of either reference.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

RER
October 13, 2005

Conferees
Robert E. Rhode Jr. *REJ*
Examiner
Art Unit 3625

Wynn Coggins *WC*
SPE
Art Unit 3625

John Weiss *John 10-17-05*
SPE
Art Unit 3621
Appeal Conference Specialist
TC 3600

Lyon & Harr, LLP
300 Esplanade Drive, Suite 800
Oxnard, California 93036